

Claim 1 is directed to a backprinting recording medium comprising a porous ink-permeable layer produced by dispersing a filler in a binding resin, wherein the binding resin constituting the ink-permeable layer has a glass transition temperature of 10°C or higher, and a Shore D hardness at 25°C of 40 or higher. The cited references do not teach or suggest the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness.

As acknowledged in the Office Action, Iwamoto does not teach or suggest the claimed binder resin having the claimed glass transition temperature and Shore D hardness. Asano is cited for its disclosure of a gloss layer comprising a resin having a glass transition temperature of 40°C or more, preferably 50 to 100°C. The Office Action acknowledges that Asano does not explicitly teach the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness. However, the Office Action asserts that Asano's binder resin inherently possesses the claimed Shore D hardness. Applicants disagree, and assert that the Office Action has not established inherency sufficient to support an obviousness rejection of the claims.

In order for prior art to anticipate a claimed invention on the ground that a limitation is inherently disclosed in the reference, the inherency must be certain. The fact that a prior art reference may have the characteristics of the claimed product is not sufficient. Inherency must be a necessary result and not merely a possible result; the mere fact that a certain thing may result from a given set of circumstances is not enough. Inherency may not be established by possibilities or probabilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); Ex parte Keith and Turnquest, 154 USPQ 320, 321 (PTO Bd. Pat. Appl & Int. 1966); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999); MPEP §2112.

As illustrated in polyester resins b and g on page 10 of the specification, and in comparative examples 1 and 2 in table 2 and the comparative example in table 3, binder

resins do not necessarily have a Shore D hardness as claimed in claim 1. Thus, although it may be possible that a given binder resin may have the claimed Shore D hardness, inherency may not be established by possibilities, as discussed above. Asano is silent as to the Shore D hardness of the binder resin, and thus Asano does not teach or suggest the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness.

Likewise, in order to establish a prima facie case of obviousness, it is incumbent on the Patent Office to establish any asserted inherency. See In re King, 231 USPQ 136 (Fed. Cir. 1986). The Office Action must provide a basis in fact and/or technical reasoning to reasonably support the assertions that the allegedly inherent characteristic of the product of the cited reference necessarily flows from the teachings of the reference. See Ex parte Levy, 17 USPQ2d 1461, 1464 (PTO Bd. Pat. Appl. & Int. 1990). Accordingly, in order to establish inherency, the Office Action must provide some evidence or scientific reasoning to establish the reasonableness of the belief that the limitation is an inherent characteristic of the prior art. Ex parte Skinner, 2 USPQ2d 1788, 1789 (PTO Bd. Pat. Appl. & Int. 1986).

Although the Office Action generally states that Asano's binder resin inherently has the claimed Shore D hardness, the Office Action has failed to provide a basis in fact and/or technical reasoning to reasonably support this assertion. Thus, the Office Action has failed to establish that Asano's binding resin has the claimed glass transition temperature and inherently has the claimed Shore D hardness.

For at least these reasons, Iwamoto, alone or in view of Asano, does not teach or suggest every feature of claim 1. Specifically, the cited references, alone or in combination, do not teach or suggest the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness. Accordingly, claim 1 is patentable over the cited references, alone or in combination. Claims 2-6 depend from claim 1, and thus include all of its limitations. Accordingly, these dependent claims are patentable over the cited

references, alone or in combination, for at least the same reasons as claim 1, as well as for their own features.

Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections over Hasegawa in View of Asano

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,027,131 to Hasegawa et al. (Hasegawa) in view of Asano. Applicants respectfully traverse the rejection.

Claim 1 and Asano are discussed above.

As acknowledged in the Office Action, Hasegawa does not teach or suggest the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness. As discussed above, and as acknowledged in the Office Action, Asano does not explicitly teach the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness. In addition, for the reasons discussed above, Asano's binder resin does not inherently possess the claimed Shore D hardness.

For at least the reasons discussed above, Hasegawa, alone or in combination with Asano, does not teach or suggest every feature of claim 1. Specifically, the cited references, alone or in combination, do not teach or suggest the claimed binder resin having the claimed glass transition temperature and the claimed Shore D hardness. Accordingly, claim 1 is patentable over the cited references, alone or in combination. Claims 2, 5 and 6 depend from claim 1, and thus include all of its limitations. Accordingly, these dependent claims are patentable over the cited references, alone or in combination, for at least the same reasons as claim 1, as well as for their own features.

Reconsideration and withdrawal of the rejection are respectfully requested.

III. New Claim

Support for new claim 7 can be found at least at page 6, lines 1-7, of the specification.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-7 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,


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Date: April 22, 2003

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